

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Dany Sylvain

Serial No. 10/784,743

Filed: 02/23/2004

Examiner: Wesley Leo Kim

Art Unit: 2617

For: **CALL TRANSFER FOR AN INTEGRATED WIRELINE AND WIRELESS SERVICE**

Mail Stop Appeal Brief – Patents

Commissioner for Patents

PO Box 1450

Alexandria, VA 22313-1450

Sir:

An **APPEAL BRIEF** is filed herewith. Appellant authorizes a payment in the amount of \$540.00 as required by 37 C.F.R. § 41.20(b)(2) to be charged to Deposit Account No. 14-1315. Appellant also encloses a payment of \$490.00 for a two-month extension of time, and requests that this be considered a petition therefor. If any additional fees are required in association with this appeal brief, the Director is hereby authorized to charge them to Deposit Account No. 14-1315, and consider this a petition therefor.

APPEAL BRIEF

(1) REAL PARTY IN INTEREST

The real party in interest is the assignee of record, i.e., Nortel Networks Limited of 2351 Boulevard Alfred-Nobel, St. Laurent, Quebec Canada H4S 2A9, which is wholly owned by Nortel Networks Corporation, a Canadian corporation.

(2) RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences to the best of Appellant's knowledge.

(3) STATUS OF CLAIMS

Claims 1-15 and 30-44 were rejected with the rejection made final on November 03, 2009. Claims 16-29 and 45-58 were previously withdrawn in response to a restriction requirement.

Claims 1-15 and 30-44 are pending and are the subject of this appeal.

(4) STATUS OF AMENDMENTS

All amendments have been entered to the best of Appellant's knowledge. No amendments have been made after the Final Office Action mailed November 03, 2009.

(5) SUMMARY OF CLAIMED SUBJECT MATTER

In the following summary, Appellant has noted where in the Specification certain subject matter exists. Appellant wishes to point out that these citations are for demonstrative purposes only and that the Specification may include additional discussion of the various elements, citations to which are not pointed out below. Thus, the noted citations are in no way intended to limit the scope of the pending claims.

Embodiments described in the present application relate to a communication environment where calls are established with a single mobile terminal through either a wireless network or via a terminal adaptor over the public switched telephone network (PSTN) or a packet network (Specification, paragraph 0005). The terminal adaptor is capable of wirelessly communicating with the mobile terminal. *Id.* As such, the mobile terminal may facilitate traditional cellular

calls via the wireless network as well as traditional PSTN or packet-based calls via the terminal adaptor. *Id.* The terminal adaptor and mobile terminal communicate via a local wireless interface, and as such, communications via the PSTN or packet network through the terminal adaptor are only possible within a limited communication zone supported by the terminal adaptor. *Id.* When the mobile terminal is involved in a call through the wireless network and is within the communication zone of the terminal adaptor, the mobile terminal may initiate a handoff. *Id.* The handoff will establish a connection between the wireless switch, which is currently supporting the call, and the mobile terminal through the terminal adaptor using a local wireless interface. *Id.* Once the connection with the mobile terminal through the terminal adaptor is established, the call is transitioned to the new connection and the mobile terminal will transfer to the local wireless interface to support the call. *Id.*

Independent claim 1 recites a method for transitioning a call with a mobile terminal (such as any of mobile terminals 12, Figures 1A-1C, 2A-2D, 3, and 6) from a cellular connection to a local wireless connection, the method comprising:

a) receiving an inter-switch handoff request from a wireless switch (such as wireless switch 18, Figures 1A-1C, 2A-2D, and 3) supporting a call to the mobile terminal over a cellular access network (such as cellular access network 20, Figures 1A-1C and 3), the call comprising a first connection from the wireless switch to the mobile terminal and a second connection between the wireless switch and an entity (Specification, paragraphs 0005, 0019, 0028, 0035-0039, and 0043; see also Figures 1B, 1C, 2B-2D, and 3, such as Figure 2B, steps 162 and 164);

b) effecting establishment of an inter-switch handoff connection to the mobile terminal via a terminal adaptor (such as terminal adaptor 16, Figures 1A-1C, 2A-2D, 3, and 4), which supports local wireless communications with the mobile terminal (Specification, paragraphs 0005, 0017-0022, 0027, 0028, 0030, 0039, 0035-0041, and 0043; see also Figures 1B, 1C, 2A-2D, and 3); and

c) providing an inter-switch handoff instruction to the wireless switch to connect the second connection and the inter-switch handoff connection to effect handoff of the call from the cellular connection to the local wireless connection (Specification, paragraphs 0005, 0017-0022, 0027, 0028, 0030, 0039, 0035-0041, and 0043; see also Figures 1B, 1C, 2A-2D, and 3).

Independent claim 30 recites a system for transitioning a call with a mobile terminal (such as any of mobile terminals 12, Figures 1A-1C, 2A-2D, 3, and 6) from a cellular connection to a local wireless connection, the system comprising:

- a) at least one communication interface (such as packet interface(s) 58, Figure 5);
- b) a control system (such as control system 52, Figure 5) associated with the at least one communication interface and adapted to:

- i) receive an inter-switch handoff request from a wireless switch (such as wireless switch 18, Figures 1A-1C, 2A-2D, and 3) supporting a call to the mobile terminal over a cellular access network (such as cellular access network 20, Figures 1A-1C and 3), the call comprising a first connection from the wireless switch to the mobile terminal and a second connection between the wireless switch and an entity (Specification, paragraphs 0005, 0019, 0028, 0035-0039, and 0043; see also Figures 1B, 1C, 2B-2D, and 3, such as Figure 2B, steps 162 and 164);

- ii) effect establishment of an inter-switch handoff connection to the mobile terminal via a terminal adaptor (such as terminal adaptor 16, Figures 1A-1C, 2A-2D, 3, and 4), which supports local wireless communications with the mobile terminal (Specification, paragraphs 0005, 0017-0022, 0027, 0028, 0030, 0039, 0035-0041, and 0043; see also Figures 1B, 1C, 2A-2D, and 3); and

- iii) provide an inter-switch handoff instruction to the wireless switch to connect the second connection and the inter-switch handoff connection to effect handoff of the call from the cellular connection to the local wireless connection (Specification, paragraphs 0005, 0017-0022, 0027, 0028, 0030, 0039, 0035-0041, and 0043; see also Figures 1B, 1C, 2A-2D, and 3).

(6) GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

A. Whether claims 1-3, 6-8, 11-15, 30-32, 35-37, and 40-44 were properly rejected under 35 U.S.C. § 102(b) as being unpatentable over U.S. Patent No. 6,373,828 B1 to Stewart et al (hereinafter “Stewart”).

B. Whether claims 4-5, 9-10, 33-34 and 38-39 were properly rejected under 35 U.S.C. § 103(a) as being unpatentable over Stewart in view of U.S. Patent No. 7,136,375 B1 to Koistinen (hereinafter “Koistinen”).

(7) ARGUMENT

A. Introduction

The Patent Office has not shown where all the elements of the independent claims are shown in the prior art with sufficient particularity to sustain an anticipation or an obviousness rejection. In particular, the Patent Office has not shown where Stewart teaches each and every limitation of the independent claims.

First, Stewart does not teach transitioning a call with a mobile terminal from a cellular connection to a local wireless connection. Stewart does not disclose a local wireless connection. Stewart discloses a handover between a Generic C-based wireless communication system and a MSC-based wireless communication system. Neither of these systems is a local wireless connection. Since the Generic C-based system is an alternate cellular system, and not a local wireless network, Stewart does not disclose transitioning a call with a mobile terminal from a cellular connection to a local wireless connection. Thus, Stewart does not teach “effecting establishment of an inter-switch handoff connection to the mobile terminal via a terminal adaptor, which supports **local wireless communications with the mobile terminal**” and does not teach “providing an inter-switch handoff instruction to the wireless switch to connect the second connection and the inter-switch handoff connection **to effect handoff of the call from the cellular connection to the local wireless connection,**” as recited in claim 1.

In addition, Stewart does not disclose a “terminal adaptor which supports local wireless communications with the mobile terminal,” as recited in independent claims 1 and 30. As discussed above, Stewart does not disclose local wireless communications. Further, Stewart does not disclose the claimed terminal adaptor.

Moreover, in the invention of claim 1, the inter-switch handoff connection is established to the mobile terminal via the terminal adapter and then the handoff is effected by connecting the already established connection between the wireless switch and the entity (referred to as the “second connection” in claim 1) with the inter-switch handoff connection to the mobile terminal via the terminal adapter. Stewart does not teach this limitation. Stewart does not teach an inter-

switch handoff connection being established to the mobile terminal via the terminal adaptor, which supports local wireless communications with the mobile terminal, as recited in claim 1. Claims 1 and 30 are therefore not anticipated by Stewart for this additional reason.

Further, the Patent Office has not shown where the prior art discloses all the features recited in the dependent claims. Koistinen does not cure the deficiencies of Stewart set forth above. Thus, the combination of Stewart and Koistinen does not teach or suggest each and every limitation of the dependent claims. As such, Appellant requests that the Board reverse the Examiner and instruct the Examiner to allow the claims for these reasons along with the reasons noted below.

B. Legal Standards

1. For Establishing Anticipation

Section 102 of the Patent Act provides the statutory basis for an anticipation rejection and states *inter alia*:

A person shall be entitled to a patent unless

(e) the invention was described in - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language. . . .

The Federal Circuit's test for anticipation has been set forth numerous times. "It is axiomatic that for prior art to anticipate under 102 it has to meet every element of the claimed invention." *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1379 (Fed. Cir. 1986). This standard has been reinforced. "To anticipate a claim, a reference must disclose every element of the challenged claim and enable one skilled in the art to make the anticipating subject matter." *PPG Indus. Inc. v. Guardian Indus. Corp.*, 75 F.3d 1558, 1577 (Fed. Cir. 1996) (citations omitted). Further, "a finding of anticipation requires that the publication describe all of

the elements of the claims, arranged as in the patented device.” *C.R. Bard Inc. v. M3 Sys. Inc.*, 157 F.3d 1340, 1349 (Fed. Cir. 1998) (emphasis added and citations omitted).

2. For Establishing Obviousness

Section 103(a) of the Patent Act provides the statutory basis for an obviousness rejection and reads as follows:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Courts have interpreted 35 U.S.C. § 103(a) as a question of law based on underlying facts. As the Federal Circuit stated:

Obviousness is ultimately a determination of law based on underlying determinations of fact. These underlying factual determinations include: (1) the scope and content of the prior art; (2) the level of ordinary skill in the art; (3) the differences between the claimed invention and the prior art; and (4) the extent of any proffered objective indicia of nonobviousness. *Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH*, 45 U.S.P.Q.2d (BNA) 1977, 1981 (Fed. Cir. 1998) (internal citations omitted).

Once the scope of the prior art is ascertained, the content of the prior art must be properly combined. “Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demand known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit. See *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006) (“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”).” *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 418, 82 U.S.P.Q.2d (BNA) 1385, 1396 (2007).

When rejecting a claim under § 103, the Patent Office must either show that the prior art references teach or suggest all limitations of the claim or explain why the difference(s) between

the prior art and the claimed invention would have been obvious to one of ordinary skill in the art. *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 418, 82 U.S.P.Q.2d (BNA) 1385, 1396 (2007). The gap between the prior art and the claimed invention may not be “so great as to render the [claim] nonobvious to one reasonably skilled in the art.” *Dann v. Johnston*, 425 U.S. 219, 230, 189 U.S.P.Q. (BNA) 257, 261 (1976).

Whether an element is implicitly or explicitly taught by a reference or combination of references is open to interpretation. While the Patent Office is entitled to give claim terms their broadest reasonable interpretation, this interpretation is limited by a number of factors. First, the interpretation must be consistent with the specification. *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000); M.P.E.P. § 2111. Second, the broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. *In re Cortright*, 165 F.3d 1353, 1359 (Fed. Cir. 1999); M.P.E.P. § 2111. Finally, the interpretation must be reasonable. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1369 (Fed. Cir. 2004); M.P.E.P. § 2111.01. This means that the words of the claim must be given their plain meaning unless applicant has provided a clear definition in the specification. *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989).

If a claim element is missing after the combination is made, then the combination does not render obvious the claimed invention, and the claims are allowable. As stated by the Federal Circuit, “[if] the PTO fails to meet this burden, then the applicants are entitled to the patent.” *In re Glaug*, 283 F.3d 1335, 1338 (Fed. Cir. 2002).

C. Summary Of References

1. U.S. Patent No. 6,373,828 B1 to Stewart

Stewart discloses a handover between a Generic C-based wireless communication system and a MSC-based wireless communication system. Neither of these systems is a local wireless connection. The Generic C-based system is an alternate cellular system implementation that leverages existing wireline switches (SSPs) to implement an alternate cellular connection in order to avoid having to deploy new MSC wireless switches (Stewart, col. 1, lines 45-52). Element 306 in Stewart is a first base station element that includes a base station controller (BSC) 313 connected to a base station transmitter/receiver (BTS) 314 (Stewart, Figure 3; and col. 4, lines 44-46). First base station element 306 is not a terminal adaptor, but rather is similar

to the second base station element 308 attached to the MSC 317 in the cellular system (Stewart, Figure 3). The first base station element 306 in Stewart supports multiple users in multiple radio cells covering large geographical areas, using CDMA protocols, like a base station in a cellular network, as discussed above. The first base station element 306 does not support communications in a small local wireless area using WLAN or 802.11 protocols.

In Stewart, the MSC in the cellular system notifies the Generic C-based system that a handoff is desired (Stewart, Figure 7, step 613). A new voice path is established between the first base station element 306 of the Generic C-based system and the MSC in the cellular system (Stewart, Figure 7, step 621). The MSC then completes the handover by dropping the portion of the radio connection between the MSC and the second base station element in the cellular system and connecting to the new voice path between the first base station element 306 of the Generic C-based system and the MSC in the cellular system (Stewart, Figure 7, step 629). Stewart thus discloses a connection being established between the first base station element 306 of the Generic C-based system and the MSC in the cellular system. In Stewart, the common connection point is at the MSC in the cellular system (there is a first connection between the MSC and the second base station element 308 in the cellular system and then a second connection between the MSC and the first base station element 306 in the Generic C-based system).

2. U.S. Patent No. 7,136,375 to Koistinen

Koistinen relates in general to avoiding multiple coding and decoding of data in data connections that involve cellular networks. In particular, Kositinen relates to extending tandem free operation to connections that pass over non-conventional telephony networks (Koistinen, col. 1, lines 13-17). Koistinen relates to a method for transmitting information related to tandem free operation, where a cellular network comprising a tandem free operation capable coding-decoding unit is connected to a packet network, an entity, which can be a second network or a terminal, is connected to the packet network and data is transmitted over the packet network between said coding-decoding unit on a first side of the packet network and said entity on a second side of the packet network (Koistinen, Abstract).

D. Claims 1-3, 6-8, 11-15, 30-32, 35-37, and 40-44 Are Patentable Over Stewart

Claim 1 recites a method for transitioning a call with a mobile terminal from a cellular connection to a local wireless connection, the method comprising:

- a) receiving an inter-switch handoff request from a wireless switch supporting a call to the mobile terminal over a cellular access network, the call comprising a first connection from the wireless switch to the mobile terminal and a second connection between the wireless switch and an entity;
- b) effecting establishment of an inter-switch handoff connection to the mobile terminal via a terminal adaptor, which supports local wireless communications with the mobile terminal; and
- c) providing an inter-switch handoff instruction to the wireless switch to connect the second connection and the inter-switch handoff connection to effect handoff of the call from the cellular connection to the local wireless connection.

1. Stewart Does Not Teach “Transitioning A Call With A Mobile Terminal From A Cellular Connection To A Local Wireless Connection” Because Stewart Does Not Disclose A Local Wireless Connection

Stewart does not teach each and every limitation of claim 1. First, Stewart does not teach transitioning a call with a mobile terminal from a cellular connection to a local wireless connection. Stewart does not disclose a local wireless connection. Stewart discloses a handover between a Generic C-based wireless communication system and a MSC-based wireless communication system. Neither of these systems is a local wireless connection. The Generic C-based system is an alternate cellular system implementation that leverages existing wireline switches (SSPs) to implement an alternate cellular connection in order to avoid having to deploy new MSC wireless switches (Stewart, col. 1, lines 45-52). Since the Generic C-based system is an alternate cellular system, and not a local wireless network, Stewart does not disclose transitioning a call with a mobile terminal from a cellular connection to a local wireless connection. Thus, Stewart does not teach “effecting establishment of an inter-switch handoff connection to the mobile terminal via a terminal adaptor, which supports local wireless communications with the mobile terminal” and does not teach “providing an inter-switch handoff instruction to the wireless switch to connect the second connection and the inter-switch

handoff connection **to effect handoff of the call from the cellular connection to the local wireless connection**,” as recited in claim 1.

In the Final Office Action, the Patent Office argues that the claim limitations are broad and that under a broad definition, the Generic C-based system of Stewart is a local wireless communication system (Final Office Action mailed November 3, 2009, p. 2). Appellant respectfully disagrees. While the Patent Office is entitled to give claim terms their broadest reasonable interpretation, this interpretation is limited by a number of factors. First, the interpretation must be consistent with the specification. *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000); M.P.E.P. § 2111. Second, the broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach. *In re Cortright*, 165 F.3d 1353, 1359 (Fed. Cir. 1999); M.P.E.P. § 2111. Finally, the interpretation must be reasonable. *In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1369 (Fed. Cir. 2004); M.P.E.P. § 2111.01. This means that the words of the claim must be given their plain meaning unless applicant has provided a clear definition in the specification. *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989). The Generic C-based system disclosed in Stewart is an alternate **cellular** system implementation (Stewart, col. 1, lines 45-52, emphasis added). Thus, the generic C-based system of Stewart is not a **local wireless** communication system under a reasonable interpretation of that claim as one skilled in the art would reach after reading the Specification of the current application.

2. Stewart Does Not Teach A “Terminal Adaptor Which Supports Local Wireless Communications With The Mobile Terminal”

In addition, Stewart does not disclose a “terminal adaptor which supports local wireless communications with the mobile terminal,” as recited in claim 1. As discussed above, Stewart does not disclose local wireless communications. Further, Stewart does not disclose the claimed terminal adaptor. The Patent Office equates element 306 of Stewart as the claimed terminal adaptor (Final Office Action mailed November 3, 2009, p. 5). Appellant respectfully disagrees. Element 306 in Stewart is a first base station element that includes a base station controller (BSC) 313 connected to a base station transmitter/receiver (BTS) 314 (Stewart, Figure 3; and col. 4, lines 44-46). First base station element 306 is not a terminal adaptor, but rather is similar

to the second base station element 308 attached to the MSC 317 in the cellular system (Stewart, Figure 3). The first base station element 306 in Stewart supports multiple users in multiple radio cells covering large geographical areas, using CDMA protocols, like a base station in a cellular network, as discussed above (see also Stewart, col. 4, lines 26-54). The first base station element 306 does not support communications in a small local wireless area using WLAN or 802.11 protocols. In the Final Office Action, the Patent Office notes that the claim does not recite WLAN or 802.11 protocols (Final Office Action mailed November 3, 2009, p. 3). While claims 1 and 30 do not specifically recite WLAN or 802.11 protocols, claims 1 and 30 do recite that the terminal adaptor “supports **local wireless communications with the mobile terminal**.” There is no discussion in Stewart that the first base station element 306 supports local wireless communications. In fact, local wireless communications (such as WLAN or 802.11) are not mentioned at all in Stewart. Accordingly, the first base station element 306 cannot be the claimed “terminal adaptor, which supports **local wireless communications with the mobile terminal**.” Therefore, Stewart does not disclose “effecting establishment of an inter-switch handoff connection to the mobile terminal via a terminal adaptor, which supports **local wireless communications with the mobile terminal**” for this additional reason.

3. Stewart Does Not Teach “An Inter-switch Handoff Connection Being Established To The Mobile Terminal Via The Terminal Adaptor”

Moreover, in the invention of claim 1, the inter-switch handoff connection is established to the mobile terminal via the terminal adapter and then the handoff is effected by connecting the already established connection between the wireless switch and the entity (referred to as the “second connection” in claim 1) with the inter-switch handoff connection to the mobile terminal via the terminal adapter. Stewart does not teach this limitation. In Stewart, the MSC in the cellular system notifies the Generic C-based system that a handoff is desired (Stewart, Figure 7, step 613). A new voice path is established between the first base station element 306 of the Generic C-based system and the MSC in the cellular system (Stewart, Figure 7, step 621). The MSC then completes the handover by dropping the portion of the radio connection between the MSC and the second base station element in the cellular system and connecting to the new voice path between the first base station element 306 of the Generic C-based system and the MSC in the cellular system (Stewart, Figure 7, step 629). Thus, Stewart never discloses an inter-switch

handoff connection being established to the mobile terminal via the terminal adaptor, as recited in claim 1. Stewart discloses a connection being established between the first base station element 306 of the Generic C-based system and the MSC in the cellular system. In Stewart, the common connection point is at the MSC in the cellular system (there is a first connection between the MSC and the second base station element 308 in the cellular system and then a second connection between the MSC and the first base station element 306 in the Generic C-based system). Stewart does not teach an inter-switch handoff connection being established to the mobile terminal via the terminal adaptor, which supports local wireless communications with the mobile terminal, as recited in claim 1. Claim 1 is therefore not anticipated by Stewart for this additional reason.

Claim 30 contains similar limitations as those recited in claim 1. Claim 30 is thus patentable for at least the same reasons discussed above with respect to claim 1.

Claims 2, 3, 6-8, and 11-15 depend from claim 1; claims 31, 32, 35-37, and 40-44 depend from claim 30. Therefore, claims 2, 3, 6-8, 11-15, 31, 32, 35-37, and 40-44 are allowable for at least the same reasons as claims 1 and 30.

E. Claims 4-5, 9-10, 33-34 and 38-39 Are Patentable Over Stewart in View of Koistinen

Claims 4, 5, 9, 10, 33, 34, 38, and 39 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Stewart in view of U.S. Patent No. 7,136,375 B1 to Koistinen (hereinafter “Koistinen”). When rejecting a claim under § 103, the Patent Office must either show that the prior art references teach or suggest all limitations of the claim or explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art. *KSR Int’l Co. v. Teleflex, Inc.*, 550 U.S. 398, 418, 82 U.S.P.Q.2d (BNA) 1385, 1396 (2007). The gap between the prior art and the claimed invention may not be “so great as to render the [claim] nonobvious to one reasonably skilled in the art.” *Dann v. Johnston*, 425 U.S. 219, 230, 189 U.S.P.Q. (BNA) 257, 261 (1976).

Claims 4, 5, 9, and 10 depend from claim 1, and claims 33, 34, 38, and 39 depend from claim 30. As discussed above, Stewart does not teach or suggest each and every limitation of claims 1 and 30. Koistinen does not cure the deficiencies of Stewart in this regard. Therefore, the Patent Office has failed to establish *prima facie* obviousness of claims 4, 5, 9, 10, 33, 34, 38,

and 39 based on the combination of Koistinen and Stewart. Accordingly, claims 4, 5, 9, 10, 33, 34, 38, and 39 are allowable for at least the same reasons as claims 1 and 30.

F. Conclusion

As set forth above, the Patent Office has not shown where all the elements of the independent claims are shown in the prior art with sufficient particularity to sustain an anticipation or an obviousness rejection. In particular, the Patent Office has not shown where Stewart teaches each and every limitation of the independent claims.

First, Stewart does not teach transitioning a call with a mobile terminal from a cellular connection to a local wireless connection. Thus, Stewart does not teach “effecting establishment of an inter-switch handoff connection to the mobile terminal via a terminal adaptor, which supports local wireless communications with the mobile terminal” and does not teach “providing an inter-switch handoff instruction to the wireless switch to connect the second connection and the inter-switch handoff connection to effect handoff of the call from the cellular connection to the local wireless connection,” as recited in claim 1.

In addition, Stewart does not disclose a “terminal adaptor which supports local wireless communications with the mobile terminal,” as recited in independent claims 1 and 30. As discussed above, Stewart does not disclose local wireless communications. Further, Stewart does not disclose the claimed terminal adaptor.

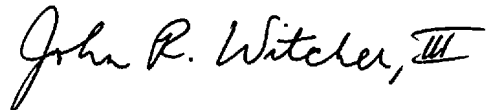
Moreover, in the invention of claim 1, the inter-switch handoff connection is established to the mobile terminal via the terminal adapter and then the handoff is effected by connecting the already established connection between the wireless switch and the entity (referred to as the “second connection” in claim 1) with the inter-switch handoff connection to the mobile terminal via the terminal adapter. Stewart does not teach this limitation. Stewart does not teach an inter-switch handoff connection being established to the mobile terminal via the terminal adaptor, which supports local wireless communications with the mobile terminal, as recited in claim 1. Claims 1 and 30 are therefore not anticipated by Stewart for this additional reason.

Further, the Patent Office has not shown where the prior art discloses all the features recited in the dependent claims. Koistinen does not cure the deficiencies of Stewart set forth above. Thus, the combination of Stewart and Koistinen does not teach or suggest each and every limitation of the dependent claims.

As such, for the reasons set forth above, Appellant requests that the Board reverse the Examiner and instruct the Examiner to allow the claims for these reasons along with the reasons noted below.

Respectfully submitted,

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(8) CLAIMS APPENDIX

1. A method for transitioning a call with a mobile terminal from a cellular connection to a local wireless connection, the method comprising:

a) receiving an inter-switch handoff request from a wireless switch supporting a call to the mobile terminal over a cellular access network, the call comprising a first connection from the wireless switch to the mobile terminal and a second connection between the wireless switch and an entity;

b) effecting establishment of an inter-switch handoff connection to the mobile terminal via a terminal adaptor, which supports local wireless communications with the mobile terminal; and

c) providing an inter-switch handoff instruction to the wireless switch to connect the second connection and the inter-switch handoff connection to effect handoff of the call from the cellular connection to the local wireless connection.

2. The method of claim 1 wherein the inter-switch handoff connection is established in part between a wireline switch and the terminal adaptor.

3. The method of claim 2 wherein the inter-switch handoff request is received and the inter-switch handoff instruction is provided using a cellular protocol while the establishment of the inter-switch handoff connection is effected using a public switched telephone network-based protocol.

4. The method of claim 2 wherein the inter-switch handoff connection is established in part between first and second media gateways, the first media gateway connected to the wireless switch via a cellular-based trunk and the second media gateway connected to the wireline switch via a public switched telephone network-based trunk, the method further comprising sending call initiation messages to the first and second media gateways and the wireline switch to establish the inter-switch handoff connection.

5. The method of claim 4 wherein the first and second media gateways facilitate interworking between the cellular-based trunk and the public switched telephone network-based trunk over a packet network.
6. The method of claim 2 wherein the inter-switch handoff connection is established using a directory number associated with the mobile terminal when supported via the terminal adaptor.
7. The method of claim 1 wherein the inter-switch handoff connection is established in part over a packet network operatively coupled to the terminal adaptor.
8. The method of claim 7 wherein the inter-switch handoff request is received and the inter-switch handoff instruction is provided using a cellular protocol while the establishment of the inter-switch handoff connection is effected using a packet-based communication session protocol.
9. The method of claim 7 wherein the inter-switch handoff connection is established in part between a first media gateway and the mobile terminal through the terminal adaptor, the first media gateway connected to the wireless switch via a cellular-based trunk, the method further comprising sending control messages to the first media gateway and the mobile terminal to establish the inter-switch handoff connection.
10. The method of claim 9 wherein the first media gateway facilitates interworking between the cellular-based trunk and a packet-based session forming part of the inter-switch handoff connection.
11. The method of claim 1 further comprising providing a inter-switch handoff message to the wireless switch to confirm handoff to the inter-switch handoff connection.
12. The method of claim 1 wherein the inter-switch handoff request comprises a cell site identifier to which the wireless switch is attempting to handoff the call, the cell site identifier corresponding to the terminal adaptor.

13. The method of claim 12 wherein the cell site identifier is provided to the wireless switch by the mobile terminal.

14. The method of claim 12 wherein the wireless switch accesses the cell site identifier upon receiving the inter-switch handoff request from the mobile terminal.

15. The method of claim 14 further comprising providing the cell site identifier to the wireless switch.

16-29. (Withdrawn)

30. A system for transitioning a call with a mobile terminal from a cellular connection to a local wireless connection, the system comprising:

- a) at least one communication interface;
- b) a control system associated with the at least one communication interface and adapted to:
 - i) receive an inter-switch handoff request from a wireless switch supporting a call to the mobile terminal over a cellular access network, the call comprising a first connection from the wireless switch to the mobile terminal and a second connection between the wireless switch and an entity;
 - ii) effect establishment of an inter-switch handoff connection to the mobile terminal via a terminal adaptor, which supports local wireless communications with the mobile terminal; and
 - iii) provide an inter-switch handoff instruction to the wireless switch to connect the second connection and the inter-switch handoff connection to effect handoff of the call from the cellular connection to the local wireless connection.

31. The system of claim 30 wherein the inter-switch handoff connection is established in part between a wireline switch and the terminal adaptor.

32. The system of claim 31 wherein the inter-switch handoff request is received and the inter-switch handoff instruction is provided using a cellular protocol while the establishment of the inter-switch handoff connection is effected using a public switched telephone network-based protocol.

33. The system of claim 31 wherein the inter-switch handoff connection is established in part between first and second media gateways, the first media gateway connected to the wireless switch via a cellular-based trunk and the second media gateway connected to the wireline switch via a public switched telephone network-based trunk, the control system further adapted to send control messages to the first and second media gateways and the wireline switch to establish the inter-switch handoff connection.

34. The system of claim 33 wherein the first and second media gateways facilitate interworking between the cellular-based trunk and the public switched telephone network-based trunk over a packet network.

35. The system of claim 31 wherein the inter-switch handoff connection is established using a directory number associated with the mobile terminal when supported via the terminal adaptor.

36. The system of claim 31 wherein the inter-switch handoff connection is established in part over a packet network operatively coupled to the terminal adaptor.

37. The system of claim 36 wherein the inter-switch handoff request is received and the inter-switch handoff instruction is provided using a cellular protocol while the establishment of the inter-switch handoff connection is effected using a packet-based communication session protocol.

38. The system of claim 36 wherein the inter-switch handoff connection is established in part between a first media gateway and the mobile terminal through the terminal adaptor, the first media gateway connected to the wireless switch via a cellular-based trunk, the control system

further adapted to send control messages to the first media gateway and the mobile terminal to establish the inter-switch handoff connection.

39. The system of claim 38 wherein the first media gateway facilitates interworking between the cellular-based trunk and a packet-based session forming part of the inter-switch handoff connection.

40. The system of claim 30 further comprising providing a inter-switch handoff message to the wireless switch to confirm handoff to the inter-switch handoff connection.

41. The system of claim 30 wherein the inter-switch handoff request comprises a cell site identifier to which the wireless switch is attempting to handoff the call, the cell site identifier corresponding to the terminal adaptor.

42. The system of claim 41 wherein the cell site identifier is provided to the wireless switch by the mobile terminal.

43. The system of claim 41 wherein the wireless switch accesses the cell site identifier upon receiving the inter-switch handoff request from the mobile terminal.

44. The system of claim 43 wherein the control system is further adapted to provide the cell site identifier to the wireless switch.

45-58. (Withdrawn)

(9) EVIDENCE APPENDIX

Appellant relies on no evidence, thus this appendix is not applicable.

(10) RELATED PROCEEDINGS APPENDIX

As there are no related proceedings, this appendix is not applicable.